

1 In view of the argument presented supra, applicant
2 respectfully submits that the Examiner's grounds for the
3 rejection of claims 1-20 under 35 U.S.C. 101 because the
4 claimed invention is directed to nonstatutory subject matter
5 no longer appear to be applicable and applicant therefore
6 respectfully requests that the Examiner withdraw this
7 rejection.

8 In response to the Examiner's rejection of claims 1-20
9 under 35 U.S.C. 102 as being clearly anticipated by Brizendine
10 et al., applicant has:

- 11 1. Cancelled claims 2-10 without prejudice or disclaimer.
- 12 2. Amended claim 1 to include the limitations of cancelled
13 claims 2-10.
- 14 3. Amended claim 11 to reflect proper dependency

15 Applicant respectfully submits that pursuant to 37 CFR
16 1.111(c), amended claim 1 defines the following advantageous
17 distinctive features that distinguish over and avoid the prior
18 art:

- 19 a) "determining if there is a
20 problem getting the check to
21 the school"[Emphasis added];
- 22 b) "sending, by the at least one
23 of the program vendor and the
24 credit card issuer, the check
25 directly to the credit card
26 holder, if answer to step t) is
27 yes"[Emphasis added]; and
- 28 c) "forwarding, by the credit card
29 holder, the check to the
30 school, if step u) is carried
31 out"[Emphasis added]

32 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)
33 that each and every limitation, inter alia those discussed
34 supra, must be met in determining patentability:

1 "All words in a claim must be
2 considered in judging the
3 patentability of that claim
4 against the prior art." [at
5 600] [Emphasis added]

6 In this same regard, the Examiner's attention is
7 respectfully directed to the decisions in In re Fuetterer, 138
8 USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563
9 (CCPA 1971).

10 When the method of providing a credit card driven tuition
11 incentive award program of the present invention is designed
12 in accordance with the advantageous distinctive features of
13 amended claim 1 discussed supra, inter alia the school
14 receives the check even if the program vendor or the credit
15 card issuer has a problem getting the check to the school.

16 Even though the advantageous feature of the present
17 invention discussed supra may not have been disclosed and
18 discussed specifically in the specification of the patent
19 application as it was originally filed, it still must be
20 relied upon as evidence of patentability, as was decided in
21 In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995),
22 where the Court held:

23 "Board of Patent Appeals and
24 Interferences erred, in
25 upholding...rejection of
26 applicant's claims, by
27 concluding that claims'
28 disclosure was matter of
29 "design choice," and that the
30 applicant's evidence and
31 arguments to contrary are not
32 present in specification and
33 are therefore unpersuasive,
34 since board is required to
35 consider totality of record and
36 is not free to disregard
37 evidence and arguments
38 presented by applicants, and

1 since there is no support for
2 proposition that evidence
3 and/or arguments
4 traversing...rejection must be
5 contained within specification,
6 given that [unpatentability] is
7 determined by totality of
8 record including, in some
9 instances most significantly,
10 evidence and arguments
11 proffered during give-and-take
12 of ex parte patent
13 prosecution." [at 1090]
14 [Emphasis added];

15 "Because the Board was required
16 to consider the totality of the
17 record, the Board was not free
18 to disregard the evidence and
19 arguments presented by Chu in
20 response to the...rejection.
21 Additionally, the Board erred
22 in apparently requiring Chu's
23 evidence and arguments
24 responsive to the...rejection
25 to be within his specification
26 in order to be considered. To
27 require Chu to include evidence
28 and arguments in the
29 specification regarding whether
30 placement of the SCR catalyst
31 in the bag retainer was a
32 matter of "design choice" would
33 be to require patent applicants
34 to divine the rejections the
35 PTO will proffer when patent
36 applications are filed." [at
37 1094] [Emphasis added]; and

38 "We have found no cases
39 supporting the position that a
40 patent applicant's evidence
41 and/or arguments traversing
42 a...rejection must be contained
43 within the specification.
44 There is no logical support for
45 such a proposition as well,

1 given that [unpatentability] is
2 determined by the totality of
3 the record including, in some
4 instances, most significantly,
5 the evidence and arguments
6 proffered during the give-and-
7 take of ex parte patent
8 prosecution." [at 1095] [Emphasis
9 added]

10 And, even though the present invention may be considered
11 simple and accomplishes only a small but genuine improvement
12 by some is not sufficient reason to deny it patent protection,
13 as was decided in Schnell et al. v. The Allbright-Nell Company
14 et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965),
15 where the Court held:

16 "Device seems simple...in light
17 of patentee's teaching, but it
18 evidently was not...at time of
19 invention; those working in the
20 field did not accomplish
21 patentee's results; that fact
22 supports conclusion that
23 patentee achieved patentable
24 invention." [at 322] [Emphasis
25 added]; and

26 "This now seems simple...in the
27 light of the Schnell teaching,
28 but is was evidently not at
29 all...at the time of the
30 invention. Those working in
31 the field did not accomplish
32 Schnell's results. That fact
33 supports the conclusion that
34 Schnell achieved patentable
35 inventions. Pyle Nat. Co. v.
36 Lewin, 7 Cir., 1937, 92 F.2d
37 628, 630, 35 USPQ 40, 42." [at
38 324] [Emphasis added]

39 The Board of Appeals expressed the same concept when it
40 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent
41 Office Board of Appeals 1967), that:

1 "Improvement over prior art,
2 even though it be simple...is
3 patentable...."[at 624]
4 [Emphasis added]; and

5 "This rejection is in error.
6 An improvement over the prior
7 art, even though it be simple
8 ...is patentable....The
9 examiner has neither cited
10 evidence establishing the
11 [unpatentability] of
12 appellant's modification of the
13 prior art nor demonstrated that
14 the improved results claimed by
15 appellants are not available
16 from their construction."[at
17 624] [Emphasis added]

18 Attention is also respectfully directed in this regard
19 to the decisions in Mercantile National Bank of Chicago et al
20 v. Quest, Inc. et al. DC., N.D. Indiana, 166 USPQ 517, In re
21 Shelby, 136 USPQ 220, and In re Irani and Moedritzer, 166 USPQ
22 24, which all indicate that simplicity does not operate as a
23 bar to patentability.

24 Applicant respectfully submits that when issuing a 102
25 rejection all of the same elements must be found in exactly
26 the same situation and united in the same way to perform the
27 identical function in the prior art patent, as was decided in
28 Kockum Industries, Inc. v. Salem Equipment, Inc., et al., 175
29 USPQ 81 (Court of Appeals, Ninth Circuit 1972), where the
30 Court held:

31 "Anticipation is strictly a
32 technical defense. Unless all
33 of the same elements are found
34 in exactly the same situation
35 and united in the same way to
36 perform the identical function
37 in a prior pleaded patent,
38 there is no anticipation."
39 Stauffer v. Slenderella Systems

1 of California, 254 F.2d 127,
2 128, 115 USPQ 347, 348-349 (9th
3 Cir. 1957); National Lead
4 Company v. Western Lead
5 Products Company, 324 F.2d
6 539, 544, 139 USPQ 324, 327-328
7 (9th Cir. 1963). "[at 82,
8 footnote 1][Emphasis added]

9 Furthermore, the Examiner's interpretation of claim
10 language must be reasonable, as was decided in In re Morris,
11 43 USPQ.2d 1753 (Fed. Cir. 1997), where the Court held:

12 "...when an examiner issues a
13 102 rejection, the applicant
14 has an obligation to
15 demonstrate that the examiner's
16 interpretation of the claim
17 language was unreasonable."
18 [Emphasis added]

19 Additionally, it is well settled that in order for a
20 rejection under 35 U.S.C. 102 to be valid, each and every
21 limitation, inter alia those discussed supra, must be met by
22 a single reference, as was supported in Scripps Clinic &
23 Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18
24 USPQ.2d 1001, 1010 (Fed. Cir. 1991), where the Court held:

25 "Anticipation under 102
26 requires identity of invention.
27 The claimed invention,
28 including each element thereof
29 as described in appropriately
30 construed claims, must have
31 been disclosed...in a single
32 reference." [Emphasis added]

33 And, in In re Schreiber, 128 F.3d 1473, 44 USPQ.2d 1429
34 (Fed. Cir. 1997), where the Court held:

35 "...to anticipate a claim, a
36 prior art reference must
37 disclose every limitation of
38 the claim..." [Emphasis added]

1 Note should also be taken in this regard to the decisions
2 in Elmer v. ICC Fabricating, 67 F.3d 1571, USPQ.2d 1417 (Fed.
3 Cir. 1995); Beachcombers, Int'l, Inc. v. Wilde Wood Creative
4 Prods., Inc., 31 F.3d 1154, 1160, 31 USPQ.2d 1653, 1658 (Fed.
5 Cir. 1994); Standard Havens Prods., Inc. v. Gencor Indus.,
6 Inc., 953 F.2d 1360, 1369, 21 USPQ.2d 1321, 1328 (Fed. Cir.
7 1991); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d
8 1264, 1267, 20 USPQ.2d 1746, 1748 (Fed. Cir. 1991); and In re
9 Spada, 911 F.2d 705, 708, 15 USPQ.2d 1655, 1657 (Fed. Cir.
10 1990).

11 Moreover, for a reference to disclose each and every
12 element of a claim, it must disclose it with sufficient
13 clarity to prove its existence, as was decided in Motorola,
14 Inc. v. Interdigital Technology Corporation, 121 F.3d 1461,
15 43 USPQ.2d 1481 (Fed. Cir. 1997), where the Court held:

16 "...for a prior art reference
17 to anticipate a claim, the
18 reference must disclose each
19 and every element of the claim
20 with sufficient clarity to
21 prove its existence in the
22 prior art...that presumed
23 knowledge, however, did not
24 grant a license to read into
25 the prior art reference
26 teachings that were not
27 there."[Emphasis added]

28 Applying the case law discussed supra to Brizendine et
29 al. in view of advantageous distinctive features a), b), and
30 c) of amended claim 1 discussed supra, it is revealed that
31 Brizendine et al. do not teach "determining if there is a
32 problem getting the check to the school"[Emphasis added],
33 "sending, by the at least one of the program vendor and the
34 credit card issuer, the check directly to the credit card
35 holder, if answer to step t) is yes"[Emphasis added], and

1 "forwarding, by the credit card holder, the check to the
2 school, if step u) is carried out" [Emphasis added] as required
3 by advantageous distinctive features a), b), and c) of amended
4 claim 1, but rather teach that the holding bank sends the
5 funds to the educational institution and are silent as to how
6 the educational institution would get the funds if the holding
7 bank had a problem getting the funds to it, i.e., Brizendine
8 et al. are silent as to a contingency plan for how the
9 educational institution would get the funds if the holding
10 bank had a problem getting the funds to it, as shown in FIG.
11 14 of Brizendine et al. and as discussed at col. 13, lines 18-
12 23 of Brizendine et al. where it is disclosed:

13 "...the club 110 delivers a
14 request to the holding bank 170
15 requesting that the holding
16 bank transfer appropriate
17 monetary funds from the
18 member's trust account to the
19 indicated educational
20 institution. In event 1406,
21 the holding bank transfers the
22 requested funds from the
23 member's trust account to the
24 educational institution."
25 [Emphasis added]

26 With this arrangement of Brizendine et al., the
27 educational institution does not receive the check if the
28 holding bank has a problem getting the check to the
29 educational institution.

30 If the Examiner, however, attempts to reject claims 1-20
31 under 35 U.S.C. 103 by merely founding individual features
32 separately and combining them in light of applicant's
33 disclosure in a piecemeal manner by using applicant's own
34 disclosure as though it were prior art, a valid approach would

1 not be met in supporting a holding of obviousness, as decided
2 in In re Kamm and Young, 17 USPQ 298 ff, where the Court held:

3 "The rejection here runs afoul
4 of a basic mandate inherent in
5 section 103 - that a piecemeal
6 reconstruction of the prior art
7 patents in the light of
8 appellants' disclosure shall
9 not be the basis for a holding
10 of obviousness." [Emphasis
11 added]

12 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656,
13 where the Court reversed a rejection on a combination of
14 references and held:

15 "References may not be combined
16 indiscriminately and with
17 guidance from applicant's
18 disclosure to show that the
19 claims are unpatentable."
20 [Emphasis added]

21 And, in Panduit Corp. v. Burndy Corp. et al., 180 USPQ
22 498, where the Court held:

23 "Inquiry into the patentability
24 must be directed toward subject
25 matter as a whole and not to
26 elements of a combination and
27 their individual novelty..."
28 [Emphasis added]

29 Applicant has provided clear and convincing evidence that
30 neither Brizendine et al. nor for that matter any of the
31 references cited by the Examiner, accomplish applicant's
32 result of providing an efficient method of providing a credit
33 card driven tuition incentive award program that, inter alia
34 allows the school to receive the check even if the program
35 vendor or the credit card issuer has a problem getting the
36 check to the school.

1 Therefore a holding of unpatentability cannot be made
2 out, as was decided by the Board of Appeals in Ex parte
3 Tanaka, Marushima and Takahashi, 174 USPQ 38, where the Board
4 held:

5 "Claims are not rejected...if
6 the prior art devices do not
7 accomplish applicant's
8 result." [Emphasis added]

9 And, in In re Wright, 122 USPQ 522 (1959), where the
10 Court held:

11 "...the mere aggregation of old
12 elements that did not perform
13 a different function is not a
14 patentable invention, but that
15 a novel combination of old
16 elements which cooperate with
17 each other to produce a new or
18 useful result or a substantial
19 increase in efficiency is
20 patentable." [Emphasis added]

21 And, further in the en banc decision in In re Dillon, 919
22 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

23 "...a prima facie case of
24 [unpatentability] requires that
25 the prior art suggest the
26 claimed compositions'
27 properties and the problem the
28 applicant attempts to solve."
29 [Emphasis added]

30 In this same regard, the Examiner's attention is
31 respectfully directed to the decisions in In re Halleck, 164
32 USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem
33 Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

34 In view of the cancellation of claims 2-10 without
35 prejudice or disclaimer, the amendment made supra to claim 1
36 to include the limitations of cancelled claims 2-10, the
37 amendment made supra to claim 11 to reflect proper dependency,

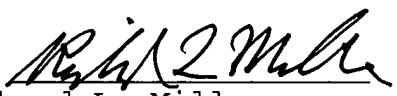
1 and the arguments presented supra, applicant respectfully
2 submits that the Examiner's grounds for the rejection of
3 claims 1-20 under 35 U.S.C. 102 as being clearly anticipated
4 by Brizendine et al. no longer appear to be applicable and
5 applicant therefore respectfully requests that the Examiner
6 withdraw this rejection.

7 In view of the foregoing remarks and amendments, it is
8 believed that claims 1 and 10-20 are in condition for
9 allowance.

10 Reconsideration and a favorable action are now kindly
11 requested.

12
13 Respectfully submitted,

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